

Appl. No. : 09/757,314
Filed : January 9, 2001

REMARKS

In response to the Office Action mailed December 15, 2003, Applicant has amended the application as above. No new matter is added by the amendments as discussed below. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the remarks set forth below.

Discussion of Claim Amendments

Claims 1-2, 10-11, 15 and 18 have been cancelled, without prejudice. Claims 3-4, 6-9, 12 and 16-17 have been amended. Claim 19 has been added. Upon the entry of the amendments, Claims 3-9, 12-14, 16-17 and 19 are pending in this application. The amendments to Claims 3-4, 6-9 and 12 are merely made to change their dependency and do not narrow the scope of protection. The amendments to Claim 16 are supported, for example, by Figure 3 and the specification at page 6, line 1. The amendments to Claim 17 are supported, for example, by Figure 10 and the specification at page 10, lines 10-21. New Claim 19 is supported, for example, by Figures 3 and 6 and the specification at page 6, line 1 and page 8, line 18. Thus, no new matter is added by the amendments. Applicant respectfully requests the entry of the amendments.

Discussion of Claim Rejections Under 35 U.S.C. § 112, ¶ 2

The Examiner has rejected Claims 1-15 under 35 U.S.C. § 112, second paragraph as being indefinite. The Examiner asserts that the essential structural relationships between the elements "first entity," "second entity," "detector," and "function select mechanism" are not recited in Claims 1 and 10. Applicant disagrees. However, in order to expedite the prosecution of the application, Applicant has cancelled Claims 1 and 10.

The Examiner also asserts in connection with Claims 13 and 15 that the limitation "selecting one out of a first function and a second function" is unclear. Applicant disagrees but to expedite the prosecution, Applicant has cancelled Claim 15. Furthermore, Applicant has already amended the claim language of Claim 13, in the previous response filed October 10, 2003, from "selecting one out of..." to "selecting one function from..." Applicant submits that no further changes are necessary to the claim. In view of the above, withdrawal of the rejections is respectfully requested.

Discussion of Claim Rejections Under 35 U.S.C. § 102(e)

The Examiner has rejected Claims 1-3, 7, 10-11 and 15-18 under 35 U.S.C. § 102(e) as being anticipated by Oguma (U.S. Patent No. 6,516,205). As discussed above, in order to expedite the prosecution of the application, Applicant has cancelled Claims 1-2, 10-11, 15 and 18. Claims 13 and 14 have been indicated to be allowable by the Examiner if amended to overcome the rejection under 35 U.S.C. § 112, second paragraph. As discussed above, Claims 13 and 14 were previously amended to overcome the § 112 rejection. Thus, Claims 13 and 14 are allowable over the prior art. Independent Claims 16-17 are not anticipated by the Oguma reference as discussed below.

Standard of Anticipation

“For a prior art reference to anticipate a claim under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 850 F.ed 675, 677, 7 USPQ 2d 1315, 1317 (Fed. Cir. 1988).

Discussion of Patentability of Independent Claim 16

Independent Claim 16 recites, among other things, *a second entity having a device function*, wherein the device function of the second entity is associated with operating the second entity in response to the first instruction and wherein *the second entity does not have a host function*. However, the Oguma reference does not disclose the above recited features as discussed below.

Applicant respectfully submits that in order to perform the intended function, the host PC (1) of Oguma must have a host function with respect to the terminal (5) or the device (6). Otherwise, the entire Oguma system would be inoperable. MPEP 2143.01. Furthermore, the device (6) of Oguma cannot be the second entity of Claim 16 because neither of the detectors (61, 64) of the terminal (arguably the claimed first entity; 5) detects the function of the device (6) whereas in the claimed invention the detector of the first entity detects the device function of the second entity.

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Discussion of Patentability of Independent Claim 17

Independent Claim 17 recites, among other things, a first entity having a host function, a device function, at least one detector and a function select mechanism, and *a second entity having a host function, a device function, at least one detector and a function select mechanism*, wherein the at least one detector of the second entity is configured to detect a function of the first entity and the function select mechanism of the second entity is configured to select one function from the host and device functions. However, the Oguma reference does not disclose the above recited features as discussed below.

Neither of the host PC (1) and the device (6) of Oguma includes the detector and the function select mechanism recited in Claim 17. There is nothing in Oguma indicating that either the host PC (6) or the device (6) can include the recited detector and function select mechanism. Furthermore, Applicant respectfully submits that neither the host PC (1) nor the device (6) needs to include the claimed detector and function select mechanism.

Summary

In view of the above, Oguma does not show the above-indicated features of independent Claims 16 and 17. Thus, the Oguma reference does not show every element of the claimed invention. Applicant respectfully submits that Oguma does not anticipate Claims 16 and 17. Furthermore, since Oguma does not teach or suggest the recited features, neither of independent Claims 16 and 17 would have been made obvious over the reference, either. Therefore both of the independent claims are patentable over the Oguma reference. Withdrawal of the rejections is respectfully requested.

Discussion of Patentability of Dependent Claims

Claims 3-9 and 12 depend from base Claim 16 or 17, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of the additional technical features, the dependent claims are patentable over the cited reference. Withdrawal of the rejections is respectfully requested.

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Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 4-6, 8-9 and 12 under 35 U.S.C. § 103 (a) as being unpatentable over Oguma. As discussed above, independent Claims 16 and 17 are patentable over the Oguma reference. Claims 4-6, 8-9 and 12 depend from base Claim 16 or 17, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of their additional technical features, the dependent claims are patentable over the cited reference. Withdrawal of the rejections is respectfully requested.

Discussion of Patentability of New Claim 19

New Claim 19 recites, among other things, a second entity *having only one of a second host function and a second device function*. However, the Oguma reference does not disclose the above recited features as discussed below. Applicant respectfully submits that the host PC (1) of Oguma, having only one of a host function and a device function, would be inoperable in view of the fact that the host PC (1) must function as a host (a host function) and is required to restart its operation in response to the resume request from the terminal (5) (identified as a device function by the Examiner during the interview) in order to provide its intended purpose (column 3, lines 35-39). Thus, removing either the host function or device function from the host PC (1) permanently would render the Oguma system unsatisfactory for its intended purpose. MPEP 2143.01. In view of the above, new Claim 19 is patentable over the Oguma reference.

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CONCLUSION

In view of Applicant's amendments to the claims and the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

5/17/04

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